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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,083	10/31/2003	Wesley Scott Ashton	ASHTON0009	9725

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EXAMINER	
RODRIGUEZ, RUTH C	
ART UNIT	PAPER NUMBER
3677	

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08/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,083	ASHTON, WESLEY SCOTT	
	Examiner	Art Unit	
	Ruth C. Rodriguez	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-27, 31,36 and 37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-31,36 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 21-27, 31, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denny et al. (US 6,047,209) in view of Edwards (US 4,943,274).

Denny disclose a method of dispensing a substance into a mouth wherein the substance is selected from a group consisting of a breath freshener, a medication and a flavoring agent (Abstract discloses using the device to dispense medication). The method comprises the steps of: (a) providing a mouth and tongue stud (103,201) including a means (104,202) for dispensing a substance formed in a portion of the stud (Abstract). The means of dispensing a substance contains the substance (Abstract). The stud comprises a bar (103,201) having ends (Fig. 3). An end member (102) is attached to one end of the bar ; (b) mounting the stud in a fistula of a wearer's tongue or in the wearer's lip (Abstract discloses the device is being used in a pierced body orifice as shown in Fig. 3); and (c) dispensing the substance into the wearer's mouth (Fig. 3). The substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. A separate embodiment discloses that the end member can

be replaced with a reservoir (407) and a knob (406) that is turned to dispense the substance. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the knob and reservoir disclosed in the embodiment of Figure 4 as the end member of the bar disclosed in the Figure 3 since the knob serves to dispense the substance. Dennis fails to disclose that the stud further comprises a second end member attached to another end of the bar that serves to secure the bar in place. However, Edwards teaches a removably mounted stud (10) that comprises a stud further comprises a bar (30) having ends, a first end member (50) is attached to one end of the bar and a second end member (16) attached to another end of the bar where first end member is removably attached to one end of the bar (Figs. 1 and 2). The stud is mounted in a fistula in the earlobe of a user by mounting the bar of the stud in the fistula formed in the wearer's earlobe and a substance is dispensed over time into the wearer's earlobe. The stud having two end members allowing permanent application of the substance into the earlobe of the wearer by providing a second end member that contains the substance (C. 1, L. 38-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the end member that contains the substance of the stud of Edwards can be applied to the stud disclosed by Denny such that the end member is connected to an opposite end of the bar that is opposite to the end member 406 to removably secured to the bar. The stud having two end members allows permanent application of the substance into the earlobe of the wearer by providing a first end member that contains the substance and the user can apply the substance to any of the

two end members. Especially for people who suffer from mouth infections that cause bad breath or that experience an infection after piercing the mouth or lip.

The substance is disposed into the wearer's mouth by injecting the substance into the piercing. Although Denny fails to disclose that the substance is disposed by dissolving the substance over time in the wearer's saliva, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance is dispensed as it travels out of the piercing and it will be dissolved over time in the wearer's saliva after being injected into the piercing since time is needed to complete dissolve the substance since the substance fails to be dissolved instantly upon application.

3. Claims 21-27, 31, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denny in view of Edwards as applied to claim 21 above, and further in view of Taylor et al. (US 5090,903).

Denny and Edwards disclose the use of medication and fail to disclose the use of a flavoring agent, a breath freshener, a flavoring agent mixed with a breath freshener, a medication mixed with a breath freshener or a medication mixed with a flavoring agent. The Examiner will like to point out that breath fresheners are usually provided with flavoring agents since the breath freshener commonly use mint as a flavoring agent. Nonetheless, Taylor teaches a device being placed in wearer's mouth to dispense a medication or breath freshener by providing three chamber that can hold a medication or breath freshener for dispensing into the wearer's mouth. The device dispenses the medication or flavoring agent into the mouth automatically (C. 2, L. 60-64). Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a medication and breath freshener dispenser into a single embodiment as taught by Taylor by having one of the end members being provided with a medication and having the other end member being provided with a breath freshener and/or flavoring agent. Doing so, dispenses the medication or flavoring agent into the mouth automatically.

Response to Arguments

4. Applicant's arguments filed 09 July 2007 have been fully considered but they are not persuasive.

5. The Applicant argues that Denny fails to disclose a mouth and tongue stud because neither the needle nor the ring includes structure that would allow them to remain in the tongue or other piercing in the mouth. This argument fails to persuade because the claim only requires stud that is mounted in the wearer's mouth or lip. The claims do not require that the stud remains in the mouth or lip. Additionally, the revised rejection clarifies that the stud 103 was modified with the embodiment shown in Figures 4 to include the knob 406 disclosed by Denny at one end as the end member and the end member 50 taught by Edwards as the other end member. Therefore, the stud will be capable of remaining in the wearer's mouth or lip.

6. The Applicant argues that the stud disclosed by Denny is meant to be used externally due to the substances being used with the stud. This argument fails to

persuade because there are topical antibiotics that are meant to be used orally when a user has an infection. Additionally, Denny does not provide any indication that the stud can only be used externally and therefore it is wrong to assume that the stud can not be used orally especially since piercing in the mouth or lip are commonly used.

7. The Applicant argues that the embodiments of Denny fail to disclose end members being provided at the ends and how a combination of the end member will not be usable in a mouth or lip. The Examiner has revised the rejection to clearly point out that the needle embodiment is being used with the reservoir 407 and knob 406 by combining the embodiments since the knob serves to dispense the substance and modifying the opposite end of the stud with the member with the end member 16 of Edwards that also serves to dispense a substance.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both devices pertain to dispensing mediation to a pierced member and therefore can be combined.

9.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., the end member 16 of Edwards will defeat its use for enhancing sexual activity since it is compressible) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Finally, the argument against member 50 is not being considered since the rejection is not using end member 50 for the combination of Denny and Edwards.

11. With respect to claims 21-27, 31, 36 and 37, the Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/RCR/
Ruth C. Rodriguez
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/James R. Brittain/
Primary Examiner
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rcr
July 20, 2007